

REMARKS

I. Status of the Claims

Claims 1-3 and 6-37 are pending in this application. Claims 12-17, 26-32, and 35-37 remain withdrawn from consideration as being directed to non elected species of invention.

II. Rejections under 35 U.S.C. § 102

The Examiner maintained the rejection of claims 1, 2, 18-21, 24, 25, 32, and 33 under 35 U.S.C. § 102(b) as being anticipated by U.S. Pat. No. 5,024,890, 5,312,687, and 5,387,468 to Pollet ("Pollet"). Applicants again acknowledge inorganic particles were the species of particles elected for examination, with boron nitride being elected as the particular species of particles to be considered for examination. See Response, p. 2.

A rejection under § 102 is only proper when the claimed subject matter, in this case a composition, is identically described or disclosed in the prior art. *In re Arkley*, 455 F.2d 586, 587 (CCPA 1972). In order to identically describe or disclose the claimed composition, the reference must direct those skilled in the art to the composition without any need for picking and choosing. *Arkley*, at 587. Pollet does not identically describe or disclose a composition comprising inorganic particles, such as boron nitride particles, and thus fails to anticipate the elected species of invention. The Examiner coorectly acknowledged this fact by not including pending claims 9-11 in the § 102(b) rejection.

In the rejection, the Examiner alleges, *inter alia*, that Pollet teaches "that inorganic particulates such as metallic fillers can be used." Final Office Action at 3. The Examiner further alleges that "if each powder particle contains polymer and filler, as taught by Pollet, the skilled artisan would reasonably presume that the fillers are either a) coated with the polymer or b) flocked on the surface of the polymer particle." *Id.* Additionally, the Examiner alleges that Pollet teaches that "the inorganic particulates can be metallic fillers. This teaching inherently describes particles that have a Mohs' hardness value which does not exceed the Mohs' hardness value of the glass fibers." Office Action 3-4.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. M.P.E.P. § 2131. Applicants respectfully submit that nothing Pollet describes any inorganic particles that inherently or explicitly have a Mohs' hardness that does not exceed the Mohs' hardness of the glass fiber. Applicants disagree that metallic fillers will necessarily and inevitably have a hardness that exceeds the hardness of the glass fibers. Applicants submit that the relative hardness varies depending on the metal and glass used. Pollet therefore fails to disclose each and every element of independent claims 1 and 32 is therefore not expressly or inherently described by Pollet.

Accordingly, Applicants respectfully request the Examiner to withdraw this rejection.

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III. Rejection Under 35 U.S.C. § 103

The Examiner has maintained the rejection of claims 3, 6-11, 22, 23, and 32-34 under 35 U.S.C. § 103(a) as being unpatentable over Pollet as applied to claims 1, 2, 18-21, 24-25 and 32-33, in view of U.S. Pat. No. 5,460,883 to Barber and U.S. Pat. No. 6,270,562 B1 to Jia. The Examiner alleges that the present "claims are nonspecific as to the Mohs' hardness value of the glass fibers. Furthermore, Pollet specifically teaches a powdered coating containing inorganic particulates that can be metallic and a powdered coating comprising composite particulates." Final Office Action at 4. The Examiner also states that Barber "teaches filaments [sic] cores coated with inorganic particulate material, wherein the filament cores can be continuous glass fibers." *Id.* The Examiner then concludes that "it would have been obvious to substitute metallic particulates with boron nitride particles depending upon the desired conductivity of the end product." *Id.*

To establish a prima facie case of obviousness, the Examiner must meet three basic criteria, including that one skilled in the art must find motivation to combine teachings from the references in the references themselves. As emphasized by Applicants in the previous response, the Examiner can meet the burden of establishing a prima facie case of obviousness "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The factual inquiry whether to combine

references must be based on objective evidence of record. *In re Lee*, 61 U.S.P.Q.2d 1430,1433 (Fed. Cir. 2002).

Applicants respectfully submit that the requisite objective teaching is not present in Pollet, Barber or Jia. Pollet is directed to a size composition "useful for impregnating a highly loaded, impregnated fibrous strand where the impregnation takes place during the fiber forming operation." See, e.g., Pollet, U.S. Patent No. 5,024,890 at col. 1, lines 10-15. Barber, on the hand, is directed to a composite abrasive filament, while Jia is directed to a filler material for dental composites. Thus, the compositions disclosed in these references are all used for widely differing applications. Given the divergent nature of these references, Applicants submit that an objective teaching could not be present: one skilled in the art trying to solve a problem with the composition of Pollet would not have been led to search the divergent teachings of Barber or Jia for a solution.

Turning to independent claims 1 and 32, Applicants additionally submit that in order to establish a prima facie case of obviousness, the Examiner must also show that all of the claim limitations are taught or suggested by the combined references. In the present case, the references are silent with respect to whether the particles have a Mohs' hardness value which does not exceed the Mohs' hardness value of the glass fiber. The Examiner may believe that, to the extent that a metal particle is used, it will inherently have a Mohs' hardness that is greater that of the glass fiber. This belief was suggested in the anticipation rejection, and as discussed above, this is not necessarily

the case. Indeed, the Examiner has not shown it to be true in all circumstances. For this additional reason, Pollet taken in combination with Barber and Jia does not teach or suggest the inventions recited in at least independent claims 1 and 32.

With respect to claims 9-11, which recite inorganic particles, such as born nitride, Applicants' elected species of particle, Applicants respectfully submit that the Examiner has not shown that it would have been obvious to use inorganic particles, such as boron nitride, in the composition of Pollet. Specifically, the Examiner has not shown how one skilled in the art would have particularly chosen, for example, the inorganic particles recited in claim 9, such as boron nitride, for use in the composition of Pollet from the myriad of other particles known in the art. Thus, nothing in the references would have rendered obvious the composition recited in claim 9, and the § 103(a) rejection must therefore fail with respect to claims 9-11.

Accordingly, Applicants respectfully request the Examiner to withdraw this § 103(a) rejection.

IV. Conclusion

In view of the foregoing remarks, Applicants respectfully request the reconsideration of this application and the timely allowance of the pending claims.

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Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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